

REMARKS/ARGUMENTS

Claims 124, 129-131 and 135-145 are pending and stand rejected in this application. The rejections to the presently pending claims are respectfully traversed.

Claim Rejections – 35 U.S.C. §101 and §112, First Paragraph

Claims 124, 129-131 and 135-145 are rejected under 35 U.S.C. §101 since allegedly "none of the asserted utilities are specific to the claimed nucleic acids, since such can be applied to any nucleic acid."

Claims 124, 129-131 and 135-145 were further rejected under 35 U.S.C. §112, first paragraph, allegedly "since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility, one skilled in the art would not know how to use the claimed invention."

Applicants have asserted that the data derived from the Gene Amplification assay was first disclosed in U. S. Provisional Patent Application Serial No. 60/141,037, filed 23 June, 1999 for the claimed PRO1153 encoding gene. Applicants further submit that, for the same detailed reasons discussed in the Appeal Brief under the section on Issue II: Utility/ Enablement, U. S. Provisional Patent Application Serial No. 60/141,037 also has patentable utility. Hence, Applicants should be able to rely upon this provisional application to provide an effective filing date of 23 June, 1999 for the instant application.

Applicants maintain, for the reasons set forth in the previously filed Appeal Brief, that the specification discloses at least one credible, substantial and specific asserted utility for the claimed PRO1153 nucleic acids. Applicants' arguments presented in the previously filed Appeal Brief are incorporated herewith in their entirety. As discussed before, the specification discloses that the gene encoding PRO1153 showed amplification, ranging from **2.014 to 2.87**-fold in two different lung primary tumors under Example 170, which is sufficient disclosure for patentable utility for the PRO1153 nucleic acids.

Thus, Applicants believe that these rejections under 35 U.S.C. §101 and §112, first paragraph, utility rejections should be withdrawn.

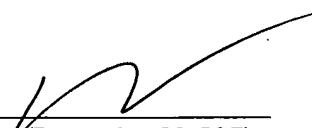
The present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641, referencing Attorney's Docket No. 39780-2730 P1C63 and direct any calls in connection with this application to the undersigned at the number provided below.

Respectfully submitted,

*(Pamper Geo
43,626)*

Date: June 30, 2006

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